USPTO COVID-19 Relief Efforts

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UNITED STATES
PATENT AND TRADEMARK OFFICE
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Agenda

- Deadline Waivers and Other Relief
- Relief to Restore Priority or Benefit Rights
- Waiver of Certain Fees
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- Waiver of Original Handwritten Signature Requirement and Relief for Plant Patent Applicants
- COVID-19 Prioritized Examination Pilot

Deadline Waivers and Other Relief

- The USPTO issued three notices regarding waiver of timing deadlines. The notices were issued March 31, 2020, April 28, 2020, and May 27, 2020. The notices permitted affected applicants to extend due dates for certain filings, if the response or fee was accompanied by a statement that the delay was due to the COVID-19 outbreak.
- The USPTO provided relief in the form of a waiver of the petition fee for the revival of patent applications (and reexamination proceedings) that became abandoned (or terminated or limited) as a result of the COVID-19 outbreak. Such petitions had to be filed by July 31, 2020.
- The USPTO provided a 30-day extension of time of an original due date (between and inclusive of March 27, 2020 and April 30, 2020) for certain patent owner responses in a trial proceeding before the Patent Trial and Appeal Board (PTAB).

Relief to Restore Priority or Benefit Rights for Patent Applicants

- On June 12, 2020, the USPTO extended the time period for petition to restore certain rights of priority or benefit in a patent application and waived the associated petition fee.

- The relief extended the two-month time-period for restoring the right of priority to or benefit of a foreign or provisional application for any nonprovisional application due to be filed after March 27, 2020, but on or before July 30, 2020.

Waiver of Certain Fees

- On June 29, 2020, the USPTO extended to September 30, 2020, the time for small and micro entities to play certain patent-related fees that would otherwise have been due on or after March 27, 2020.
  - The small or micro entity fees eligible for an extension included basic filing fees, basic national fees, issue fees, and maintenance fees.

Deferred-fee provisional patent applications program

- On September 16, 2020, the USPTO announced the deferred-fee provisional patent application pilot program.
- Applicants may request deferred payment of the provisional application filing fee until the filing of a corresponding nonprovisional application.
- In turn, applicants must agree that the technical subject matter disclosed in their provisional applications will be made available to the public via a searchable collaboration database maintained on the USPTO's website.
  - Provisional applications are generally maintained in confidence per 35 U.S.C. 122(a).
  - Required program form PTO/SB/452 includes applicant's waiver of this confidentiality provision.

Subject matter eligible for the deferred-fee program

- The subject matter disclosed in the provisional application must concern a product or process related to COVID-19.
- The product or process must be subject to an applicable Food and Drug Administration (FDA) approval for COVID-19 use. It is acceptable if the approval
  - has been obtained,
  - is pending, or
  - will be sought prior to marketing.
- The FDA approval requirement is the same for both the deferred-fee program and the COVID-19 prioritized examination program.

Duration of the deferred-fee program

- The deferred-fee program will accept certifications and requests for participation for a period of 12 months, beginning on September 17, 2020.
- The USPTO may extend the pilot program (with or without modifications) or terminate it depending on the workload and resources needed to administer it, feedback from the public, and its effectiveness.
- Depending on feedback and public interest, the technological scope could also be expanded beyond COVID–19 to other areas that are the focus of pioneering or rapid innovation.

View of deferred-fee program database*

https://foiadocuments.uspto.gov/provisionalapplication/

Identification number	Date of filing	Date available to public	First inventor	Title of invention
DFPUB_62/706952	09/20/2020	09/23/2020	Kasravi	Locking mask strap
DFPUB_62/706972	09/22/2020	09/30/2020	Koren	Mask with flow-controlled UV light intensity sterilization
DFPUB_63/198003	09/23/2020	10/14/2020	Brown	Hypoxia-inducible factor prolyl hydroxylase inhibitors for treating respiratory distress in patients with COVID-19
DFPUB_63/198192	10/01/2020	10/28/2020	Koren	Mask with flow-controlled UV light intensity sterilization
DFPUB_63/198249	10/06/2020	10/28/2020	Brown	Non-invasive vagus nerve stimulation during sleep to aid in COVID-19 recovery: a novel electroceutical approach
DFPUB_63/198228	10/05/2020	10/28/2020	Garnio	Methods of treating infection and symptoms caused by SARS-CoV-2 using lithium
DFPUB_63/198742	11/09/2020	11/25/2020	Tandon	Prophylactic control of novel pathogens using sunlight
DFPUB_63/198730	11/09/2020	12/09/2020	Shin	Methods, systems, and devices for facilitating a health protection protocol

* Columns for assignee and contact information not shown.

Prior art considerations

- A submission under the program will result in a public disclosure of the technical subject matter and may be citable as prior art under 35 U.S.C. 102(a)(1) as of the date it is added to the database. However, the USPTO does not consider this public disclosure to constitute publication of a patent application under 35 U.S.C. 122(b) because provisional patent applications are not published; see 35 U.S.C. 122(b)(2)(A)(iii).
- A provisional patent application submitted under the program may become prior art under 35 U.S.C. 102(a)(2) as of its filing date, but only if there has been a proper benefit claim under 35 U.S.C. 119(e) in a later-filed nonprovisional application or international application and the later-filed application has been published or deemed published under 35 U.S.C. 122(b) or has issued as a U.S. patent.

Prior art considerations, continued

- A publication in the collaboration database cannot be used against the inventor's own corresponding later-filed nonprovisional application in the United States, provided that the later-filed application is filed within one year of the publication; see 35 U.S.C. 102(b)(1)(A).

- However, applicants should be aware that some foreign jurisdictions treat an inventor's public disclosure made within one year of filing as prior art against the inventor's own application unless that earlier disclosure is the subject of a proper priority claim in that jurisdiction.

Relief for Delays in Filing Certified Copies of Foreign Priority Applications

- Some foreign IP offices are not currently issuing paper certified copies of foreign applications due to the COVID-19 outbreak.
- On February 1, 2021, the USPTO announced relief under certain conditions to suspend the requirement for a paper certified copy of a foreign application when the foreign application was filed in a foreign IP office that does not participate in a bilateral or multilateral priority document exchange program with the USPTO.
- If the USPTO grants a request to suspend the certified copy submission requirement, the USPTO will proceed to issue the patent with the foreign priority claim on the front page of the patent.

Relief for Delays in Filing Certified Copies of Foreign Priority Applications, continued

- Once the foreign IP office resumes processing requests for paper certified copies, the patentee must:
  - Comply with the foreign IP office's requirements for obtaining a paper certified copy (which may include submitting a new request for a paper copy) within two months after the date the foreign IP office resumes processing requests for paper certified copies, and
  - Submit a paper certified copy to the USPTO within one month after the date the paper certified copy is issued form the foreign IP office.
- The paper certified copy does not need to be accompanied by a petition for delayed submission of a certified copy if filed within the time period identified above.

Platform to Facilitate Connections Between Patent Holds and Potential Licensees in Key Technologies

- The USPTO unveiled a new web-based intellectual property (IP) marketplace platform, Patents 4 Partnerships, to provide the public with a user-friendly, searchable repository of patent and published patent applications related to the COVID-19 pandemic that are indicated as available for licensing.
  - https://developer.uspto.gov/ipmarketplace/search/patents
- The platform facilitates voluntary licensing and commercialization of innovations in a variety of key technologies, and helps disseminate valuable patent information by helping to bring to marketplace new products and technologies for the prevention, treatment, and diagnosis of COVID-19.

Waiver of Original Handwritten Signature Requirement and Relief for Plant Patent Applicants

- The USPTO *sua sponte* waived the requirements for an original handwritten signature personally signed in permanent dark ink or equivalent for correspondence requiring a person's signature relating to:
  - Registration to practice before the USPTO in patent cases, enrollment and disciplinary investigations, and disciplinary proceedings
  - Payments by credit cards where the payment it not being made via the USPTO's electronic filing systems
- The USPTO is temporarily permitting the filing of plant patent applications and follow-on documents via the USPTO patent electronic filing systems until further notice.

COVID-19 Prioritized Examination Pilot Program

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COVID-19 Prioritized Examination Program

- The USPTO considers the effects of the COVID-19 outbreak to be an "extraordinary situation," such that fees not required by statute may be waived.
- Accordingly, the USPTO is accepting requests for prioritized examination for applications that claim a product or process related to COVID–19 without the additional fee.
- The USPTO's goal is to provide a final disposition within *six months* of prioritized status being granted if applicants respond within 30 days to a notice from the USPTO.

COVID-19 Prioritized Examination Pilot Program Requirements

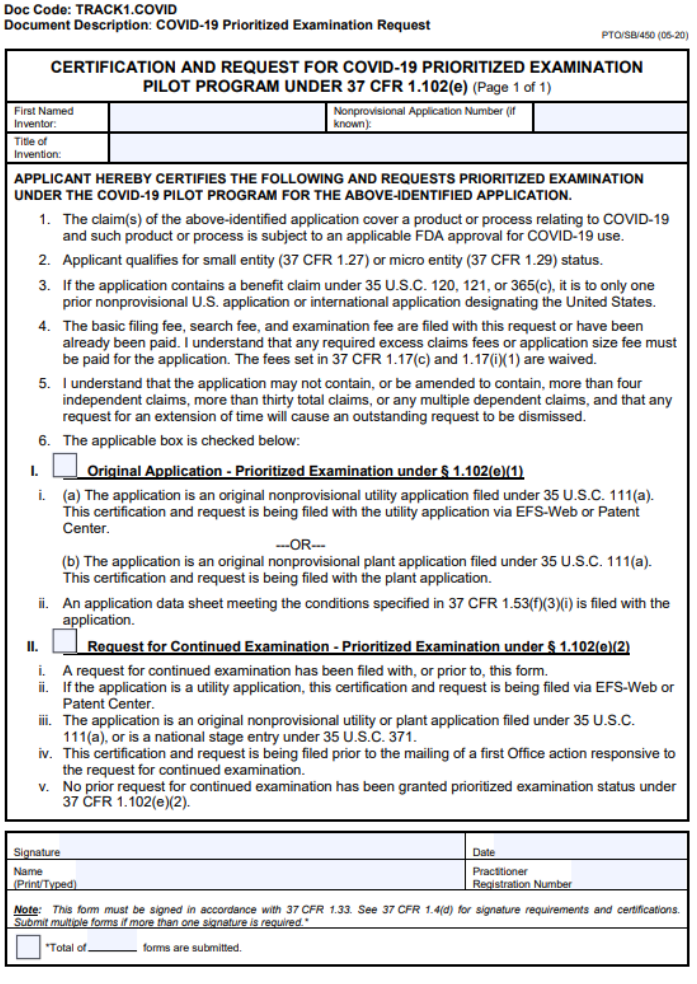
- **Same requirements as Prioritized Examination (Track 1) except:**
  - The prioritized examination fee is waived.
  - Open to small and micro entities only.
  - The application must be a non-continuing nonprovisional application or a continuing application claiming the benefit of one nonprovisional application or one prior international application designating the United States.
  - Applicants must certify claim(s) of the application must cover a product or process subject to an applicable FDA approval for COVID–19 use.
  - The request must include an Application Data Sheet (ADS).

COVID-19 Prioritized Examination Pilot "FDA Certification"

- Applicants must certify their applications claim products or processes that are subject to an applicable FDA approval, which may include, *but are not limited to*: an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA).
- "Subject to . . . approval" does not mean approval has already been sought or granted, but rather that the product or process covered by the claim is subject to the FDA's jurisdiction before it can be marketed for use in prevention, diagnosis, or treatment of COVID-19.

Requesting prioritized examination under the pilot

- Applicants are encouraged to submit form PTO/SB/450.
- Form PTO/SB/450 contains the necessary certifications for qualification to participate in the pilot.
- Use of form PTO/SB/450 will also enable the USPTO to quickly identify and timely process the request.



Doc Code: TRACK1.COVID
Document Description: COVID-19 Prioritized Examination Request

PTO/SB/450 (05-20)

CERTIFICATION AND REQUEST FOR COVID-19 PRIORITIZED EXAMINATION PILOT PROGRAM UNDER 37 CFR 1.102(e) (Page 1 of 1)

First Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			

APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION UNDER THE COVID-19 PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION.

1. The claim(s) of the above-identified application cover a product or process relating to COVID-19 and such product or process is subject to an applicable FDA approval for COVID-19 use.
2. Applicant qualifies for small entity (37 CFR 1.27) or micro entity (37 CFR 1.29) status.
3. If the application contains a benefit claim under 35 U.S.C. 120, 121, or 365(c), it is to only one prior nonprovisional U.S. application or international application designating the United States.
4. The basic filing fee, search fee, and examination fee are filed with this request or have been already been paid. I understand that any required excess claims fees or application size fee must be paid for the application. The fees set in 37 CFR 1.17(c) and 1.17(i)(1) are waived.
5. I understand that the application may not contain, or be amended to contain, more than four independent claims, more than thirty total claims, or any multiple dependent claims, and that any request for an extension of time will cause an outstanding request to be dismissed.
6. The applicable box is checked below:

I. ☐ **Original Application - Prioritized Examination under § 1.102(e)(1)**

i. (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web or Patent Center.

---OR---

(b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application.

ii. An application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is filed with the application.

II. ☐ **Request for Continued Examination - Prioritized Examination under § 1.102(e)(2)**

i. A request for continued examination has been filed with, or prior to, this form.
ii. If the application is a utility application, this certification and request is being filed via EFS-Web or Patent Center.
iii. The application is an original nonprovisional utility or plant application filed under 35 U.S.C. 111(a), or is a national stage entry under 35 U.S.C. 371.
iv. This certification and request is being filed prior to the mailing of a first Office action responsive to the request for continued examination.
v. No prior request for continued examination has been granted prioritized examination status under 37 CFR 1.102(e)(2).

Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	

Note: *This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.**

☐ *Total of _____ forms are submitted.

Duration of the COVID-19 prioritized examination

- **Until 500 requests are accepted:**
  - As of June 8, 2021: 678 filed / 418 granted / 82 available
- **The USPTO may extend, modify, or terminate the program depending on the workload and resources needed to administer the program, feedback from the public, and the effectiveness of the program.**
- **Comments may be addressed to: *Covid19PrioritizedExamPilot@uspto.gov*.**
- **More information available at: https://www.uspto.gov/initiatives/covid-19-prioritized-examination-pilot**

Thank you!

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